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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/905,401	07/12/2001	Thomas Robert Gruber	VIGN1840	5195
44654	7590	05/09/2006	EXAMINER	
SPRINKLE IP LAW GROUP 1301 W. 25TH STREET SUITE 408 AUSTIN, TX 78705			HOFFMAN, BRANDON S	
			ART UNIT	PAPER NUMBER
			2136	

DATE MAILED: 05/09/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/905,401	GRUBER, THOMAS ROBERT	
	Examiner	Art Unit	
	Brandon S. Hoffman	2136	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 28 February 2006.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-29 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-29 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. Claims 1-29 are pending in this office action, claim 29 is newly added.
2. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on February 28, 2006, has been entered.
3. Applicant's arguments with respect to claims 1-29 have been considered but are moot in view of the new ground(s) of rejection.

Claim Rejections

4. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claim Rejections - 35 USC § 103

5. Claims 1, 3-5, 7, 13, 14, 17, 22, 25, and 29 are rejected under 35 U.S.C. 103(a) as being unpatentable over Allen et al. (U.S. Patent Pub. No. 2002/0068629 A1) in view of Wong et al. (U.S. Patent No. 6,968,364).

Regarding claims 1 and 29, Allen et al. teaches a method of conducting a secure transaction with an on-line service while offline comprising the steps of:

- Issuing a token to a user from an application server for the on-line service while the user is online **with the online service** (fig. 3 and fig. 4, ref. num 424/426);
- Preparing an off-line transaction object containing data to specify and request the **secure** transaction (all of fig. 5);
- Sending a message to the on-line service, said message containing the **off-line** transaction object (fig. 3 and fig. 6, ref. num 610);
- Upon receipt of **said** message, the application server validating the token to authenticate the user and to authorize the **secure** transaction (fig. 6, ref. num 612); and
- Executing the **off-line** transaction object if the **secure** transaction is authorized (fig. 6, ref. num 614/618).

Allen et al. does not teach obtaining a transaction authorization token from an application server while on-line, sending a message including the transaction authorization token, or validating the **transaction authorization** token at the on-line service provider, **wherein the application server performs said validating while the user is offline from the online service**

Wong et al. teaches obtaining a transaction authorization token from an application server while on-line (col. 3, lines 55-58, downloading the token from the

server), sending a message including the transaction authorization token (fig. 5, the attachments), and validating the **transaction authorization** token at the on-line service provider (col. 20, lines 7-14), **wherein the application server performs said validating while the user is offline from the online service** (col. 20, lines 10-14, e-mails are send asynchronously and do not require the sender to be online for the receiver to receive and verify).

It would have been obvious to one of ordinary skill in the art, at the time the invention was made, to combine obtaining a transaction authorization token, sending the transaction authorization token in a message, and validating the transaction authorization token while the user is off-line, as taught by Wong et al., with the method of Allen et al. It would have been obvious for such modifications because a transaction authorization token allows automatic configuration of the PVR, or any other device, in response to receiving a message containing the transaction authorization token (see col. 20, lines 7-14 of Wong et al.).

Regarding claim 3, the combination of Allen et al. in view of Wong et al. teaches wherein the **authorization** token is issued to the user via a download operation while the user is on-line **with the on-line service** (see fig. 4, ref. num 426 of Allen et al.).

Regarding claim 4, the combination of Allen et al. in view of Wong et al. teaches wherein the user prepares the **off-line** transaction object **while the user is off-line from the on-line service** (see paragraph 0043 of Allen et al.).

Regarding claim 5, the combination of Allen et al. in view of Wong et al. teaches **further comprising requesting a transaction authorization token**, wherein the user requests the **transaction authorization** token for the **secure** transaction from the application server **for the on-line service** (see fig. 4, ref. num 424/426 and paragraph 0040 of Allen et al.).

Regarding claim 7, the combination of Allen et al. in view of Wong et al. teaches wherein **said issuing a transaction authorization token** comprises **generating** a unique identifier when the token is issued, **wherein said generating is performed by the on-line service** (see fig. 3, ref. num 320 of Allen et al.).

Regarding claim 13, the combination of Allen et al. in view of Wong et al. teaches wherein the **transaction authorization** token includes data representing a time period during which the **transaction authorization** token is valid (see end of paragraph 0052 of Allen et al.).

Regarding claim 14, the combination of Allen et al. in view of Wong et al. teaches wherein the **transaction authorization** token includes data representing a valid access

duration for the **transaction authorization** token (see end of paragraph 0052 of Allen et al.).

Regarding claim 17, the combination of Allen et al. in view of Wong et al. teaches further comprising encrypting the **off-line** transaction object (see paragraph 0040 of Allen et al.).

Regarding claim 22, the combination of Allen et al. in view of Wong et al. teaches wherein the application server is a web-based application server (see paragraph 0019 of Allen et al.).

Regarding claim 25, the combination of Allen et al. in view of Wong et al. teaches further comprising authenticating a user **such that the user is online with the on-line service, wherein said authenticating is performed** with a password and a network identity while the user is **logging-on to** the on-line service (see paragraph 0035 of Allen et al.).

Claims 2, 6, 9-12, 15, 16, 19-21, 23, 24, and 26-28 are rejected under 35 U.S.C. 103(a) as being unpatentable over Allen et al. (USPGPUB '629) in view of Wong et al. (USPN '364), and further in view of Fischer (U.S. Patent Publication No. 2002/0010638 A1).

Regarding claim 2, Allen et al./Wong et al. teaches all the limitations of claim 1, above. However, Allen et al./Wong et al. does not teach wherein the token is issued to the user via an e-mail message sent from the application server **for the on-line service**.

Fischer teaches wherein the token is issued to the user via an e-mail message sent from the application server **for the on-line service** (paragraph 0025).

It would have been obvious to one of ordinary skill in the art, at the time the invention was made, to combine issuing the token via an e-mail message sent from the application server, as taught by Fischer, with the method of Allen et al./Wong et al. It would have been obvious for such modifications because sending tokens via e-mail provides a user the credentials required for secure processing that can be saved and used at a later time. This is similar to a user signing up for a service (hotmail.com for example) and receiving an e-mail message with the login credentials in the e-mail message.

Regarding claim 9, the combination of Allen et al. in view of Wong et al./Fischer teaches wherein the application server receives an incoming message including the **transaction authorization** token, checks the **transaction authorization** token for validity, and accepts or rejects the **transaction authorization** token (see fig. 6, ref. num 614 of Allen et al.).

Regarding claim 10, the combination of Allen et al. in view of Wong et al./Fischer teaches wherein **said sending a message to the on-line service containing the transaction authorization token and off-line transaction object comprises sending an e-mail message delivered to the application server via an asynchronous e-mail delivery method** (see paragraph 0005 of Fischer).

Regarding claim 11, the combination of Allen et al. in view of Wong et al./Fischer teaches where the asynchronous delivery mechanism is database record synchronization (see paragraph 0034 of Fischer).

Regarding claim 12, the combination of Allen et al. in view of Wong et al./Fischer teaches where the asynchronous e-mail delivery method comprises a synchronization of data between a portable computing device and an on-line service (see paragraph 0022 of Fischer).

Regarding claim 21, the combination of Allen et al. in view of Wong et al./Fischer teaches wherein the application server **authorizes** a specific transaction by a specific user on specific data objects **such that the transaction authorization token can be used only once** (see fig. 3, ref. num 318/320 and paragraph 0048 of Allen et al.).

Regarding claim 6, Allen et al./Wong et al. teaches all the limitations of claims 1 and 5, above. However, Allen et al./Wong et al. does not teach wherein the **on-line**

service comprises the application server, and wherein the application server accesses a database.

Fischer teaches wherein the **on-line service comprises the application server, and wherein** the application server accesses a database (paragraph 0034).

It would have been obvious to one of ordinary skill in the art, at the time the invention was made, to combine accessing a database, as taught by Fischer, with the method of Allen et al./Wong et al. It would have been obvious for such modifications because the database contains products to be ordered, by accessing the database, correct quantities can be obtained.

Regarding claim 15, Allen et al./Wong et al. teaches all the limitations of claim 1, above. However, Allen et al./Wong et al. does not teach wherein the **transaction authorization** token specifies an e-mail audit signature, and said **transaction authorization** token is valid only if the transaction is sent from an e-mail program via an e-mail delivery path that matches the e-mail audit signature.

Fischer teaches wherein the **transaction authorization** token specifies an e-mail audit signature, and said **transaction authorization** token is valid only if the transaction is sent from an e-mail program via an e-mail delivery path that matches the e-mail audit signature (paragraph 0025).

It would have been obvious to one of ordinary skill in the art, at the time the invention was made, to combine an e-mail audit signature for verifying the token, as taught by Fischer, with the method of Allen et al./Wong et al. It would have been obvious for such modifications because the audit signature prevents intruders from using a different e-mail address to trick the system into thinking the intruder is authorized.

Regarding claim 16, the combination of Allen et al. in view of Wong et al./Fischer teaches wherein an e-mail address to which the message is sent varies according to an authorized data object and transaction type (see paragraph 0025 of Fischer).

Regarding claim 19, Allen et al./Wong et al. teaches all the limitations of claim 1, above. However, Allen et al./Wong et al. does not teach wherein the **transaction authorization** token is contained in a body or a header of an e-mail message.

Fischer teaches wherein the **transaction authorization** token is contained in a body or a header of an e-mail message (paragraph 0025).

It would have been obvious to one of ordinary skill in the art, at the time the invention was made, to combine the token contained in a body or header of an e-mail message, as taught by Fischer, with the method of Allen et al./Wong et al. It would have been obvious for such modifications because containing the token in the body of

an e-mail message provides further authentication and authorization (see paragraph 0025 of Fischer).

Regarding claim 20, Allen et al./Wong et al. teaches all the limitations of claim 1, above. However, Allen et al./Wong et al. does not teach wherein the **transaction authorization** token and the **off-line** transaction object are attachments to an e-mail message.

Fischer teaches wherein the **transaction authorization** token and the **off-line** transaction object are attachments to an e-mail message (paragraph 0025).

It would have been obvious to one of ordinary skill in the art, at the time the invention was made, to combine the token and transaction object are attachments to an e-mail message, as taught by Fischer, with the method of Allen et al./Wong et al. It would have been obvious for such modifications because containing the token as an attachment of an e-mail message provides further authentication and authorization (see paragraph 0025 of Fischer).

Regarding claim 23, Allen et al./Wong et al. teaches all the limitations of claim 1, above. However, Allen et al./Wong et al. does not teach **wherein** said **secure** transaction is selected from the group consisting of a database modification, update, adding a file, and editing a file.

Fischer teaches **wherein** said **secure** transaction is selected from the group consisting of a database modification, update, adding a file, and editing a file (paragraph 0022).

It would have been obvious to one of ordinary skill in the art, at the time the invention was made, to combine transactions consisting of modifications, updating, adding a file, and editing a file, as taught by Fischer, with the method of Allen et al./Wong et al. It would have been obvious for such modifications because editing a file allows the user to obtain the exact purchase order desired by the user.

Regarding claim 24, the combination of Allen et al. in view of Wong et al./Fischer teaches **the group consisting of a database modification, update, adding a file, editing a file**, checking out a file, editing the file off-line, and checking in the file as an e-mail attachment (see fig. 4, ref. num 64/66/68 of Fischer).

Regarding claim 26, Allen et al./Wong et al. teaches all the limitations of claim 1, above. However, Allen et al./Wong et al. does not teach wherein the user comprises a software agent **adapted to conduct** the transaction on behalf of the user.

Fischer teaches wherein the user comprises a software agent **adapted to conduct** the transaction on behalf of the user (paragraph 0020).

It would have been obvious to one of ordinary skill in the art, at the time the invention was made, to combine a software agent that conducts transactions on behalf of the user, as taught by Fischer, with the method of Allen et al./Wong et al. It would have been obvious for such modifications because a software agent provides an automated process for the user to order products from a vendor.

Regarding claim 27, Allen et al./Wong et al. teaches all the limitations of claim 1, above. However, Allen et al./Wong et al. does not teach wherein the user sends the message to the on-line service while the user is offline from the **online service**.

Fischer teaches wherein the user sends the message to the on-line service while the user is offline from the **online service** (paragraph 0019).

It would have been obvious to one of ordinary skill in the art, at the time the invention was made, to combine sending the message to the service while the user is offline from the online service, as taught by Fischer, with the method of Allen et al./Wong et al. It would have been obvious for such modifications because the user can provide the message ahead of time without having to log in to the service (see paragraph 0019 of Fischer). This saves time for the user by having the message already provided to the on-line service.

Regarding claim 28, the combination of Allen et al. in view of Wong et al./Fischer teaches wherein the message to the on-line service is sent via e-mail (see paragraph 0025 of Fischer).

Claims 8 and 18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Allen et al. (USPGPUB '629) in view of Wong et al. (USPN '364), and further in view of Konheim et al. (U.S. Patent No. 4,393,269).

Regarding claim 8, Allen et al./Wong et al. teaches all the limitations of claim 1, above. However, Allen et al./Wong et al. does not teach wherein the **transaction authorization** token is a one-way encryption of at least one of an identity of the user, a transaction type, and a data object for which the transaction is authorized.

Konheim et al. teaches wherein the **transaction authorization** token is a one-way encryption of at least one of an identity of the user, a transaction type, and a data object for which the transaction is authorized (col. 23, lines 52-62).

It would have been obvious to one of ordinary skill in the art, at the time the invention was made, to combine an one-way encryption of the identity to create the token, as taught by Konheim et al., with the method of Allen et al./Wong et al. It would have been obvious for such modifications because the one-way encryption of the

identity provides a method for verifying both the content of the transaction and the parties involved (see abstract of Konheim et al.).

Regarding claim 18, Allen et al./Wong et al. teaches all the limitations of claims 1 and 17, above. However, Allen et al./Wong et al. does not teach wherein said encrypting comprises issuing a temporary public key that is a one-way encryption function of an address to which the **secure** transaction is to be sent for encryption of the **off-line** transaction object.

Konheim et al. teaches wherein said encrypting comprises issuing a temporary public key that is a one-way encryption function of an address to which the **secure** transaction is to be sent for encryption of the **off-line** transaction object (col. 23, lines 52-62).

It would have been obvious to one of ordinary skill in the art, at the time the invention was made, to combine using an one-way encryption function for encrypting the transaction object, as taught by Konheim et al., with the method of Allen et al./Wong et al. It would have been obvious for such modifications because the one-way encryption of the identity provides a method for verifying both the content of the transaction and the parties involved (see abstract of Konheim et al.).

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Brandon S. Hoffman whose telephone number is 571-272-3863. The examiner can normally be reached on M-F 8:30 - 5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ayaz R. Sheikh can be reached on 571-272-3795. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Brandon S. Hoffman

BH

CHRISTOPHER REVAK
PRIMARY EXAMINER

CEL 5/4/06